

REMARKS

By this amendment, the drawings, specification and claims 1-3, 5-8, 10, and 13 have been revised and new claim 15 has been added to place this application in condition for allowance. Currently, claims 1, 2, 5, 6 and 9-13, and 15 are before the Examiner for consideration on their merits, and claims 3, 4, 7, 8, and 14 have been withdrawn from consideration.

First and in response to the objection to the specification, Applicants assert that the problems noted by the Examiner in the PTO copy of the specification are not found in the as-filed copy. In an effort to resolve this situation, Applicants are enclosing herewith a clean copy of the specification as filed. It is obvious when comparing the copy of the specification as filed that is attached herewith to the alleged errors listed in the Office Action that the PTO copy has been corrupted for some reason. Since the specification does not need any changes, it is not submitted herewith as a substitute specification, but it is submitted for entry as a proper copy for use by the PTO. If the Examiner would like to resolve the problem with the PTO copy of the specification in a different manner, the Examiner is invited to telephone the undersigned at 202-835-1753.

Regarding the comments on the IDS, the specification has been revised on page 1 to correctly identify the referenced EP patent. Moreover, this EP Patent as well as the one cited on page 2 of the specification are listed in Applicants' IDS, and therefore are properly of record. Therefore, there is no need for submission of an additional IDS.

Concerning the drawings, corrected drawings are filed concurrently herewith via a Letter to the Draftsperson. The drawings make the following corrections.

- 1) Figures 1 and 1bis are relabeled as 1a and 1b.
- 2) The proper cross hatching is included where appropriate.
- 3) Reference numerals 22a and 22b are inserted in the Figures 2a and 2b, respectively, and the hatching in Figure 2a is removed.
- 4) Reference numeral 10 is inserted in Figure 3 and reference numeral 30 is inserted in Figure 4b.
- 5) The specification is changed on line 14, page 7, to correctly identify recesses 21e.
- 6) Reference numerals 22, B1 and B2 are added to Figure 6.
- 7) New Figure 1c is added to include illustration of a link insert so as to comply with Rule 83a and claim 4.
- 8) New Figure 11 is added to cover the embodiment of Figures 3 and 4 and to provide support for claim 10.

More specifically, the addition of new Figures 1c and 11 do not add new matter to the specification. The link insert of claim 4 is shown in United States Patent No. 5,377,962 to Ochs et al. as a friction layer 7 or sleeve 25. Since this insert is well known in the art, it has been illustrated in Figure 1c in the context of the teachings of the Ochs et al. patent, and new matter is not introduced by the addition of this drawing. Regarding Figure 11, page 10, lines 1-5 provide clear support for the embodiment of Figures 3 and 4, i.e., wherein the fluting is on the outside face. Showing such fluting in Figure 11 is based from the original description. Figure 11 shows a close up of a projection 20e', which is similar to the projection of Figure 6 wherein the projection is provided with a hyperbolic shape. Since the specification originally described the

projection with a curved or hyperbolic shape, illustrating this detail does not add new matter to the specification.

In summary, it is contended that each of the drawing/specification changes addresses each and every issue raised in the Office Action, and therefore, the drawing objection should be withdrawn.

Turning now to the rejection under 35 U.S.C. § 112, first paragraph, Applicants respectfully contend that the specification clearly enables one of skill in the art to practice the invention described in Figure 5. The specification clearly explains that the split allows the ring to be expanded when the ring is placed around the hub. The split then allows the ring to be compressed so that it can be inserted in the space formed by the rim. The absence of play occurs when the ring is sandwiched between the hub and rim, and there is no issue of non-enablement in this regard. The Examiner is invited to telephone the undersigned to discuss this matter further if this issue would hold up allowance of the application.

Applicants would also like to traverse the rejection of claims 1, 2, 5, 6, and 9-13 under 35 U.S.C. § 112, second paragraph. In the Office Action, the Examiner has questioned whether the decoupling element is claimed alone or in combination with the central hub and rim. It is Applicants intention to claim just the decoupling ring in a manner that it is adapted to interface with the hub and rim. In light of this, the claims have been revised where appropriate to make it clear that the ring is adapted to mesh with the facing face. In light of these amendments, it is respectfully asserted that the claims are fully definite in this regard.

It is also contended that the claims are not indefinite by virtue of the term "decoupling". One function of the ring is to "decouple" the drive and the rim, i.e., avoid transmitting vibrations at particular frequencies. Thus, calling the element a "decoupling element" does not raise an issue of indefinites when viewed from the perspective of one of ordinary skill in the art.

The problem with claim 6 has been resolved by making it dependent on claim 2. Claims 10 and 13 have been revised in response to the allegations of indefiniteness.

In summary, all claims are within the purview of 35 U.S.C. § 112, second paragraph, and the rejection under this statutory section must be withdrawn.

Prior to discussing the prior art rejection, Applicants would like the Examiner to note that claim 15 is added as a combination of the decoupling element and the two supports, and examination of this claim is respectfully requested.

In the prior art rejection, the Examiner makes a number of rejections under 35 U.S.C. § 102(b) or (e). Claim 6 is also rejected under 35 U.S.C. § 103(a).

It is Applicants contention that the rejections based on anticipation are improper and the traversal is set forth below under headings of the applied prior art.

Krysczk

Kryscyk discloses a resilient element for a clutch coupling in which the radial projections 52 are interposed and compressed in an angular direction between the claws 28 of the first claw ring 32 and claws 24 of the first flange 22. Both the claw ring 32 and the flange 22 face the same external face of the resilient elements. Therefore, the central core does not work in shear as is required by the claim 1.

To reiterate, claim 1 clearly sets forth a decoupling element that has a central core with opposite faces, at least one of the opposite faces having abrupt projections adapted to mesh with complementary abrupt projections of a facing face of the support.

Bugatti

The Examiner's reliance on Bugatti as an anticipatory reference is misplaced since Bugatti does not teach a decoupling element with radial projections. While Figure 2 may appear to disclose radial projections, a careful reading of the specification, see col. 3, lines 45-62, reveals that only the hub D and the sleeve B have such projections. These projections extend into the rubber bushing E making it appear to have its own projections. In fact, the recesses shown in Figure 2 are a result of the projections on D and B, and a recess in E. What looks like projections in Figure 2, are, in fact, uncompressed parts of the bushing E which equate to the real outer periphery. Since Bugatti does not teach a decoupling element with the abrupt projections as defined in claim 1, this reference cannot serve as an anticipatory one.

Moreover, there is no reason to modify Bugatti and arrive at the invention without recourse to hindsight, and any allegation of this nature could not support an obviousness rejection.

Olbrich

Olbrich is also not grounds for rejecting the claims under 35 U.S.C. § 102(b) since it also lacks the features of claim 1. In Olbrich, a resilient member 2 is interposed between a rotating shaft 1 and an inertial ring 3 to function as a spring member in a vibration chanceller. The technical characteristics of such a resilient member are very different from those of the decoupling element of the invention since the later is intended to transmit a

torque which suppresses some frequency components of the driving excitation, whereas Olbrich's device is only a freely-rotating mechanical oscillator. Since Olbrich is not a decoupling element, it cannot be used to reject claim 1, and the rejection based on this prior art reference must be withdrawn.

Further, there is no basis to conclude that Olbrich somehow establishes a *prima facie* case of obviousness, and any such rejection could only be the result of the hindsight reconstruction of the prior art in light of Applicants disclosure.

Claim 6

In the rejection, the Examiner contends that claim 6 is obvious based on the search report. It is respectfully contended that this is an improper basis to reject claim 6. The burden is on the Examiner to establish a *prima facie* case of obviousness, and this burden cannot be replaced by the mere issuance of a search report.

Moreover, the two references cited by the Examiner, EP 0 740 077 (EP) and DE 196 18 635 (DE) cannot establish a *prima facie* case of obviousness because there is no reason to combine the two references. EP discloses a resilient element having smooth projections which slide on the meshing projections of the corresponding support when an excessive torque is applied. In contrast, DE discloses a non-resilient coupling element (17) with a thermoplastic coating (20), see col. 3, lines 54-59. Given the disparate teachings of these two references, one of skill would not be motivated to combine these two references to arrive at the invention defined by claim 6, and the rejection must be withdrawn for this reason. The Examiner is called upon to provide objective factual evidence if a further rejection of claim 6 is made.

Claim 10

The Examiner notation regarding claim 10 is noted. However, it is respectfully submitted that claim 10 is fully definite when viewed in light of the specification, and that it is patentable since no prior art was applied thereagainst.

Claim 15

Claim 15 is added to claim the combination of the decoupling ring, and two supports. Clearly, this combination is not taught by any of the applied prior art, especially when considering the claim 1 requirement that the central core of the decoupling element works in shear. Therefore, this claim is patentably distinguishable over each of Kryscyk, Bugatti, and Olbrich.

Lastly, since claim 1 is believed to be patentable over the applied prior art, and it is a generic claim, the restriction requirement should be withdrawn as it applies to claims 3, 4, 7, 8, and 14, and claims 1-15 should be allowed. Moreover, claim 14 is readable on the species defined by Figures 2-6. Clearly, the description of the embodiment of Figure 6 in the specification coincides with the language of claim 14, and this claim should be grouped with claims corresponding to the elected species regardless of whether the restriction requirement is withdrawn.

In summary, it is respectfully contended that each and every issue raised in the outstanding Office Action has been addressed herein. Thus, all claims are fully definite under the purview of 35 U.S.C. § 112, second paragraph, the drawings and specification are in order, and the claims are neither anticipated nor rendered obvious by the applied prior art references of Kryscyk, Bugatti, or Olbrich.

Accordingly, the Examiner is requested to examine this application in light of this response and pass claims 1-15 onto issuance.

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If the Examiner believes that an interview with Applicants attorney would be helpful in expediting the allowance of this application, the Examiner is respectfully requested to telephone the undersigned at 202-835-1753.

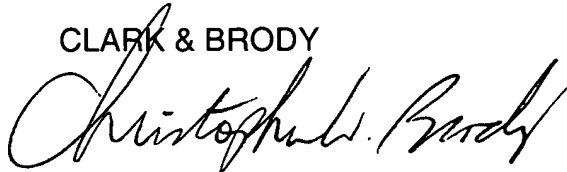
The above constitutes a complete response to all issues raised in the Office Action dated March 22, 2005.

Again, reconsideration and allowance of this application is respectfully requested.

Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,

CLARK & BRODY

A handwritten signature in cursive script, reading "Christopher W. Brody".

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